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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
KENNEDY, TIMOTHY J

ART UNIT	PAPER NUMBER
1791	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/585,065	HUSEMANN ET AL.	
	Examiner	Art Unit	
	TIMOTHY KENNEDY	1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 June 2006* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/29/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. The restriction requirement made on 3/6/2009 has been withdrawn, and all claims will be examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 4 describes what monomers are possible for components (a1) and (a2) of claim 2. The list cannot be true for both components. The chemistry and information given for the two components makes claim 4 indefinite. It is not possible that components (a1) and (a2) can be from the same list of monomers (as laid out in claim 4), since their glass transition temperatures and chemical makeup's are different. For examination purposes claim 4 is being interpreted as a list of monomers for component (a1). Clarification is requested.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Everaerts et al (U.S. Patent 6,734,256: herein after referred to as Everaerts 256), in view of Everaerts et al (U.S. Patent 5,905,099: already of record, herein after referred to as Everaerts 099). Regarding claim 1, Everaerts 256 teaches:

9. A heat-activable pressure-sensitive adhesive comprising a polymer or copolymer formed from a monomer composition comprising at least 50% by weight of a compound of the formula CH2=CH(R1)(COOR2), wherein R1 represents H or CH3 and R2

represents H or an alkyl chain having 1 to 30 carbon atoms (Abstract, column 9 lines 54-67 through column 10 lines 1-4, and column 11 lines 6-26)

10. A molecular weight distribution Mw/Mn of 2.5 or less (Table 2, polydispersity values)

11. Everaerts 256 does not teach:

12. The polymer or copolymer having a static glass transition temperature of -10°C to 120°C

13. A temperature activation range of 15°C or less

14. In the same field of endeavor Everaerts 099 teaches a static glass transition temperature of 0°C to 40°C (column 4, lines 50-67 and column 5, lines 1-20) and a temperature activation of 70°C or less (column 3, lines 31-45)

15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the static glass transition temperature and temperature activation range as taught by Everaerts 099, using the composition of Everaerts 256, since using the glass transition temperature in that range produces a better pressure sensitive adhesive (column 4, lines 50-67 and column 5, lines 1-20), and having the temperature activation in that range makes the adhesive a more useful product (column 3, lines 31-45)

16. Regarding claim 2, Everaerts 099, for the previously stated reasons, teaches:

17. The monomer composition comprises: (a1) 10% to 85% by weight of an acrylate or methacrylate ester of a nontertiary alcohol, whose homopolymer has a static glass transition temperature of 0°C or less; (a2) 0 to 70% of an acrylate or methacrylate ester

of an alcohol, whose homopolymer has a static glass transition temperature of at least 50°C; and (a3) 5% to 50% by weight of a monomer which carries a polar functional group (column 2, lines 48-57)

18. Regarding claim 3, Everaerts 099, for the previously stated reasons, teaches:

19. Components (a1) and (a2) are selected from the group consisting of acrylic and methacrylic esters each having alkyl groups of 4 to 9 carbon atoms (column 5, lines 39-46)

20. Further regarding claim 3, Everaerts 256 also teaches that the components of the heat-activable pressure sensitive adhesive should consist of methacrylic esters each having alkyl groups of 4 to 9 carbon atoms (column 9 lines 42-53 and column 10 lines 65-67 through column 11 lines 1-5)

21. Regarding claim 4, Everaerts 099, for the previously stated reasons, teaches:

22. Components (a1) and (a2) are selected independently of one another from a group which embraces the group consisting of methyl acrylate, methyl methacrylate, ethyl acrylate, n-butyl acrylate, n-butyl methacrylate, n-pentyl acrylate, n-hexyl acrylate, n-heptyl acrylate, n-octyl acrylate, n-octyl methacrylate, n-nonyl acrylate, lauryl acrylate, stearyl acrylate, behenyl acrylate, and the branched isomers thereof.

23. Everaerts 099 teaches ethyl acrylate, n-butyl acrylate, n-octyl acrylate, n-octyl methacrylate, and branched isomers thereof (isobutyl acrylate, 2-ethylhexyl acrylate, 2-ethylhexyl methacrylate, isooctyl acrylate, and isooctyl methacrylate) (column 5, lines 47-53)

24. Further regarding claim 4, Everaerts 256 further teaches many of the claimed monomers in column 10, lines 5-13 and column 11, lines 27-36.

25. Regarding claim 5, Everaerts 099, for the previously stated reasons, teaches:

26. Component (a2) is selected from the group consisting of monofunctional acrylates and methacrylates of bridged substituted or unsubstituted cycloalkyl alcohols having at least 6 carbon atoms (column 7, lines 5-15)

27. Regarding claim 6, Everaerts 099, for the previously stated reasons, teaches:

28. Component (a2) is selected from the group consisting of cyclohexyl methacrylates, isobornyl acrylate, isobornyl methacrylates, and 3,5-dimethyladamantyl acrylate (column 7, lines 5-15)

29. Regarding claim 7, Everaerts 099, for the previously stated reasons, teaches:

30. The polar group of component (a3) is a carboxyl, sulfonic acid, phosphonic acid, hydroxyl, lactam, lactone, N-substituted amide, N-substituted amine, carbamate, epoxy, thiol, ether, alkoxy or cyano group (column 5 lines 66-67 through column 6 lines 1-5)

31. Regarding claim 8, Everaerts 099, for the previously stated reasons, teaches:

32. The polymer or copolymer has a static glass transition temperature of 0°C to 100°C (column 4, lines 50-67 and column 5, lines 1-20)

33. Regarding claim 9:

34. Said monomer composition is polymerized by controlled free-radical addition polymerization

35. Both Everaerts 256 (column 11, lines 55-60) and Everaerts 099 (column 9, lines 48-51) teach free-radical polymerization. The term "addition" is inherent to the free-radical polymerization technique.

36. Regarding claims 10 and 11, Everaerts 256 further teaches:

37. Claim 10) An adhesive tape comprising the heat activable pressure-sensitive adhesive of claim 1.

38. Claim 11) The adhesive tape of claim 10, wherein the heat activable pressure-sensitive adhesive is coated onto one or both sides of a carrier.

39. Everaerts 256 teaches that similar types of heat-activable pressure sensitive adhesive compositions can be use for double sided tape (column 16, lines 39-46)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY KENNEDY whose telephone number is (571) 270-7068. The examiner can normally be reached on Monday to Friday 9:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on (571) 272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tjk

/Joseph S. Del Sole/

Supervisory Patent Examiner, Art Unit 1791